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Paper No. 15

In re Application of :
Bradley J. Coates *et al* : DECISION ON PETITION
Application No. 09/448,086 :
Filed: November 23, 1999 :
Attorney Docket No. 4002-2236

This is a decision on the petition filed on June 26, 2002 by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a timely and proper reply to the Office letter dated August 4, 2001. Petitioners request relief pursuant to 37 CFR 1.181, but in the alternative, also request relief pursuant to 37 CFR 1.137. Pursuant to MPEP §§ 1002.02(b) and 1002.02(c), the undersigned will only consider the petition pursuant to 37 CFR 1.181, for which no fee is required.

The petition under 37 CFR 1.181 is denied.

Petitioners state that having received the Office letter dated August 4, 2001, (a final rejection which is of record as paper No. 10), petitioners prepared and filed a reply thereto which included a terminal disclaimer on January 17, 2002 (these papers are of record as paper Nos. 11 and 12). Petitioners further state that they thereafter received a Notice of Abandonment dated May 1, 2002, and that the Notice of Abandonment indicated that the terminal disclaimer was not accepted because it was signed by a person not listed as an attorney of record. Petitioners also state that they never received an advisory action informing them any deficiencies in their response, and that the response may not have been timely inspected pursuant to MPEP § 714.05. Based upon these events, petitioners request withdrawal of the holding of abandonment.

It is noted that the action to which paper Nos. 11 and 12 were directed was a final rejection. Pursuant to 37 CFR 1.113 and 1.116, the type of reply which may be filed in response to a final rejection is limited. It is clear that a reply that includes a defective terminal disclaimer is not an acceptable reply to a final rejection. As discussed in MPEP §§ 714.12 and 714.13, applicants filing a reply to a final rejection have the affirmative duty to file a reply which does satisfy the requirements of 37 CFR 1.113 and 1.116, as well as a duty to monitor the status of any reply which is filed. The record clearly shows, and petitioners do not dispute, that the reply filed on January 17, 2002 was not such a reply. Petitioners do not allege that they monitored the status of this reply, or that they filed a reply as listed in 37 CFR 1.113 or 1.116. While the record does show that no advisory action was mailed prior to the mailing of the Notice of Abandonment, MPEP § 711.03(c) clearly states that:

> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

For the foregoing reasons, there is no basis for withdrawing the holding of abandonment pursuant to 37 CFR 1.181. The application is being forwarded to the Office of Petitions for consideration of the relief requested under 37 CFR 1.137.

PETITION DENIED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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